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10/620,718

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EXAMINER

RANGREJ, SHEETAL

ART UNIT

PAPER NUMBER

3626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/620,718

Applicant(s)

TALLAL, JOSEPH L.

Examiner

Sheetal R. Rangrej

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

Prosecution History Summary

- Claims 1-30 are pending.

Priority

- This application receives the date of application no. 60/396,883 filed on July 17, 2002.

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 110. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "104" and "202" have both been used to designate "individual"; reference characters "106", "206", and "302" have all been used to

designate "service/good provider"; reference characters "102", "252", and "1002" have all been used to designate "insurance company"; reference characters "108", "254" and "1004" have all been used to designate "major medical premium"; reference characters "112", "258", and "1010" have all been used to designate "major medical payment"; reference characters "110" and "256" have both been used to designate "co-pay"; reference characters "314", "402", "408", "410", "412", "414" and "416" have all been used to designate "member"; reference characters "418", "420", "422", "424", and "426" have all been used to designate "provider"; reference characters "210", "504", "710", "810", and "1006" have all been used to designate "membership fee"; reference characters "204" and "502" have both been used to designate "network provider"; reference characters "212", "712", "812", and "1008" have all been used to designate "discount price"; reference characters "604", "902", and "1116" have all been used to designate "receive membership fees from new and renewing members"; reference characters "614", "908", and "1120" have all been used to designate "provide basic/premium listings and price lists to members"; reference characters "618", "916", and "1124" have all been used to designate "periodically update information provided to members"; reference characters "640", "932", and "1138" have all been used to designate "premium listing"; reference characters "644", "936", and "1142" have all been used to designate "pay premium listing fee"; reference characters "642", "934", and "1140" have all been used to designate "provide basic listing information"; reference characters "646", "938", and "1144" have all been used to designate "provide

premium listing information"; reference characters "664", "962", and "1162" have all been used to designate "pay membership fee to join member-provider network"; reference characters "208" and "1012" have both been used to designate "service/good provider listing and discount price list"; reference characters "606" and "1112" have both been used to designate "receive premium listing fees & information from providers"; reference characters "608" and "1114" have both been used to designate "receive basic listing information from providers"; reference characters "610" and "1110" have both been used to designate "receive advertising fees from third parties"; reference characters "612" and "1118" have both been used to designate "place advertisements in content provided to members"; reference characters "616" and "1122" have both been used to designate "receive & process feedback from members, providers, & advertisers"; reference characters "634" and "1132" have both been used to designate "join member-provider network"; reference characters "636" and "1134" have both been used to designate "agree to existing price list"; reference characters "648" and "1146" have both been used to designate "provide goods or services to members"; reference characters "650" and "1150" have both been used to designate "receive payment for goods or services provided based on price list at time of delivery"; reference characters "666" and "1166" have both been used to designate "search provider list by area & services/goods provided"; reference characters "668" and "1168" have both been used to designate "select provider & review provider listing & price list"; reference characters "670" and "1170" have both been used to designate "provider

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acceptable"; reference characters "672" and "1172" have both been used to designate "contact selected provider"; reference characters "674" and "1174" have both been used to designate "receive goods or services from provider"; and reference characters "1148" and "1176" have both been used to designate "deductible reached". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 1-26 of this application conflict with claims 1-23, 26, 27, and 28 of Application No. 10/620,904. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.
5. Claims 1-7, 10-18, and 21-26 of this application conflict with claims 1-22 of Application No. 10/620,903. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

DETAILED ACTION

Claim Objections

6. Claim 19 is objected to because of the following informalities: missing a period at the end of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 8, 25, and 29 are rejected under 35 U.S.C. 101.

Referring to claim 1. If the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter. The examiner interprets a "network provider", "one or more medical service/good providers", and "one or more individuals" to be human beings, therefore it is a statutory subject matter.

Referring to claim 8. If the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter. The examiner interprets "physicians...physical therapists...chiropractors, dentists..." to be human beings, therefore it is a statutory subject matter.

Referring to claims 25 and 29. Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in

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other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute "descriptive material." Abstract ideas, Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, Schrader, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Both claims 25 and 29 recite a computer program that is embodied on a computer-readable medium, but does not positively execute the program. The claims are merely directed to a computer program per se.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1 and 24-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claims 1 and 24-30 recite the limitation "multi-level network." The specification does not clearly point out what a "multi-level network" is therefore the examiner finds the phrase indefinite. For examination purposes, the examiner interprets the multi-level network to mean that a member can pay certain amount of money for each level of access it wants.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-10, 17, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reference U.

13. As per claim 1, Reference U teaches a system comprising:

- a. A network provider that provides a health care plan, i.e. The Dental Club is a program designed for individuals, which allows members to access dental services (U: page 3).
 - b. One or more medical service/good providers that have joined the health care plan, i.e. with over 6,000 participating dentists throughout the state (U: page 12).
 - c. One or more individuals that are members of the health care plan and participate via incentives within a member multi-level network, i.e. The Dental Club is a program designed for individuals, which allows members to access dental services at significantly reduced rates when they visit a participating contracted dentist (U: page 3).
 - d. A discount price list provided by the network provider that regulates the cost of services/goods provided to the members by the medical service/good providers such that the members pay the medical service/good providers in-full directly for any services/goods rendered based on the discount price list, i.e. FDH also provides, i.e. if paid annually, you will receive a Dental Club identification card, a list of our service providers, a schedule of fees...(U: page 19).
14. As per claim 2, the system of claim 1 is as described above.
- Reference U teaches wherein the discount price list is a variable discount price list that tracks a known standard service price list, i.e FDH provides a monthly provider update on disk to all contracted groups (U: page 9).

15. As per claim 3, the system of claim 1 is as described above.

Reference U teaches wherein the individuals pay a membership fee to the network provider to join the health care plan, i.e. For a low monthly fee of just \$5 (single)...to receive Dental Club...services (U: page 19).

16. As per claim 4, the system of claim 3 is as described above.

Reference U teaches wherein the membership fee is paid by the individual's employer, i.e. FDH is an independent, portable network. FDH aligns itself with over 40 insurance companies, plan administrators, and employer groups (U: page 9). In light of the specification, the examiner interprets that if the employer group is contracted with FDH, then its paying a fee for its employees.

17. As per claim 5, the system of claim 3 is as described above.

Reference U teaches wherein the membership fee is paid by the individual's business, i.e. self-funding, voluntary, and dual and triple options are all available using FDH's networks (U: page 12).

18. As per claim 6, the system of claim 3 is as described above.

Reference U teaches wherein the membership fee is a renewal fee, i.e. for a low monthly fee of just \$5 (single)...receive a Dental Club...services (U: page 19). In light of the specification, the examiner interprets that each month you need to pay a fee, making it a renewal fee.

19. As per claim 7, the system of claim 1 is as described above.

Reference U teaches wherein the member includes his/her family in the health care plan, i.e. for a low monthly fee of...\$7 (families)...(U: page 19).

20. As per claim 8, the system of claim 1 is as described above.

Reference U teaches wherein the medical service/good providers are selected from the group consisting of dentists (U: page 3).

21. As per claim 9, the system of claim 1 is as described above.

Reference U teaches wherein the medical service/good provider is a doctor that works for a corporation, i.e. FDH offers prompt, friendly, and helpful assistance to the dentists participating in our networks. We strongly value your participation in our network, and are therefore committed to offering you and your offices (corporation) the support you deserve (U: page 8).

22. As per claim 10, the system of claim 1 is as described above.

Reference U teaches further comprising a medical service/good provider listing provided by the network provider to the members, i.e. if paid annually, you will receive a Dental Club identification card, a list of our service providers, a schedule of fees...(U: page 19).

23. As per claim 17, the system of claim 10 is as described above.

Reference U teaches wherein the discount price list and the medical service/good provider listing is accessible via a global telecommunications network, i.e. FDH is committed to offering prompt, friendly, and helpful assistance...(U: page 5). In light of

the specification, the examiner interprets that is the assistance is prompt, the a global telecommunications network is being used to provide information.

24. As per claim 27, Reference U teaches a system comprising:

- a. A network provider that provides a health care plan, i.e. The Dental Club is a program designed for individuals, which allows members to access dental services (U: page 3).
- b. One or more medical service/good providers that enter the health care plan and participate via incentives within a provider multi-level network, i.e. with over 6,000 participating dentists throughout the state (U: page 12).
- c. One or more individuals that are members of the health care plan, i.e. The Dental Club is a program designed for individuals, which allows members to access dental services at significantly reduced rates when they visit a participating contracted dentist (U: page 3).
- d. A discount price list provided by the network provider that regulates the cost of services/goods provided to the members by the medical service/good providers such that the members pay the medical service/good providers in-full directly for any services/goods rendered based on the discount price list, i.e. if paid annually, you will receive a Dental Club identification card, a list of our service providers, a schedule of fees...(U: page 19).

25. Claims 25-26 and 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Reference A (U.S. Patent No. 5,819,092).

26. As per claim 25, Reference A teaches a computer program embodied on a computer readable medium for providing a health care plan, comprising:

- a. A code segment for receiving a membership fee from one or more individuals to become members of the health care plan and participate via incentives within a member multi-level network (A: column 35, lines 24-28).
- b. A code segment for obtaining information from one or more medical service/good providers that have joined the health care plan (A: column 35, lines 24-28; column 36, lines 14-17).
- c. A code segment for providing a discount price list that regulates the cost of services/goods provided to the members by the medical service/good providers such that the members pay the medical service/good providers in-full directly for any services/goods rendered based on the discount price list (A: column 31, lines 26-31). In light of the specification, the examiner interprets that being able to provide a "yellow pages" style online service means that a code segment was used to create the list.

27. As per claim 26, Reference A teaches an apparatus for providing a health care plan, comprising:

- a. A server (A: column 7, lines 42-47; column 7, lines 60-62).
- b. One or more storage devices communicably coupled to the server, the one or more data storage devices containing a discount price list that regulates the cost of services/goods provided to a member of the health care plan by a

medical service/good provider such that the member pays the medical service/good provider in-full directly for any services/goods rendered based on the discount price list (A: column 7, lines 64-66).

c. A communications interface communicably coupled to the server that allows a member to access the discount price list (A: column 7, lines 48-50).

d. Wherein the member is an individual that has paid a membership fee to join the health care plan and participate via incentives within a member multi-level network (A: column 8, lines 15-16; column 35, lines 24-28).

28. As per claim 29, Reference A teaches a computer program embodied on a computer readable medium for providing a healthcare plan, comprising:

a. A code segment for receiving a membership fee from one or more individuals to become members of the health care plan (A: column 35, lines 24-28).

b. A code segment for obtaining information from one or more medical service/good providers that have joined the health care plan (A: column 35, lines 24-28; column 36, lines 14-17).

c. A code segment for providing a discount price list that regulates the cost of services/goods provided to the members by the medical service/good providers such that the members pay the medical service/good providers in-full directly for any services/goods rendered based on the discount price list (A: column 31, lines 26-31). In light of the specification, the examiner interprets

that being able to provide a "yellow pages" style online service means that a code segment was used to create the list.

29. As per claim 30, Reference A teaches an apparatus for providing a health care plan, comprising:

- a. A server (A: column 7, lines 42-47; column 7, lines 60-62).
- b. One or more storage devices communicably coupled to the server, the one or more data storage devices containing a discount price list that regulates the cost of services/goods provided to a member of the health care plan by a medical service/good provider such that the member pays the medical service/good provider in-full directly for any services/goods rendered based on the discount price list (A: column 7, lines 64-66).
- c. A communications interface communicably coupled to the server that allows a member to access the discount price list (A: column 7, lines 48-50).
- d. Wherein the member is an individual that has paid a membership fee to join the health care plan and the medical service/good provider joins the health care plan and participate via incentives within a member multi-level network (A: column 8, lines 15-16; column 35, lines 24-28).

Claim Rejections - 35 USC § 103

30. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

31. Claims 11-16, 18-24, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reference U in view of Reference A (U.S. Patent No. 5,819,092).

32. As per claim 11, the system of claim 10 is as described above.

Reference U does not teach wherein the medical service/good provider listing comprises basic listings and premium listings.

Reference A teaches wherein the medical service/good provider listing comprises basic listings and premium listings (A: column 8, lines 55-67 to column 9, lines 1-8).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Reference U with Reference A. One of ordinary skill would have been motivated to combine these teachings because Reference A discloses that "with the increasing popularity of computer communications, many companies are becoming interested in advertising and supporting their products using an online computer service that can be accessed by customers" (A: column 1, lines 18-21).

33. As per claim 12, the system of claim 11 is as described above.

Reference U does not teach wherein the basic listings are provided to medical service/good providers free of charge.

Reference A teaches wherein the basic listings are provided to medical service/good providers free of charge (A: column 8, lines 59-61; column 30, lines 51-52). In light of the specification, the examiner interprets "general online information"

to be the same as basic listing. The examiner also interprets that the service must be free of charge due to no fees being charged for providing general online information to the user.

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Reference U with Reference A. One of ordinary skill would have been motivated to combine these teachings because Reference A discloses that "a fee can be levied on users who access certain parts of an otherwise free online service" (A: column 30, lines 52-53).

34. As per claim 13, the method of claim 11 is as described above.

Reference U does not teach wherein the premium listings are provided to medical service/good providers upon payment of a premium listing fee.

Reference A teaches wherein the premium listings are provided to medical service/good providers upon payment of a premium listing fee (A: column 9, lines 1-5).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Reference U with Reference A. One of ordinary skill would have been motivated to combine these teachings because Reference A discloses that "developing the customized software requires a competent programming staff and a good deal of time" (A: column 1, lines 26-30).

35. As per claim 14, the method of claim 11 is as described above.

Reference U does not teach wherein the premium listings include a link to a customizable web page for the medical service/good providers that are accessible via a global telecommunications network.

Reference A teaches wherein the premium listings include a link to a customizable web page for the medical service/good providers that are accessible via a global telecommunications network (A: column 10, lines 16-19; column 10, lines 55-61).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Reference U with Reference A. One of ordinary skill would have been motivated to combine these teachings because Reference A discloses that "for a company to develop an online presence, creating a world-wide web server would provide a feature rich online service available to customers and clients" (A: column 1, lines 65-67).

36. As per claim 15, the system of claim 11 is as described above.

Reference U does not teach wherein the premium listings include a link to the medical service/good provider's website.

Reference A teaches wherein the premium listings include a link to the medical service/good provider's website (A: column 14, lines 14-16; column 13, lines 24-28). In light of the specification, the examiner interprets "a hyperlink to a dedicated online service" to be the same as a medical service/good provider's website.

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Reference U with Reference A. One

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of ordinary skill would have been motivated to combine these teachings because Reference A discloses that "for a company to develop an online presence, creating a world-wide web server would provide a feature rich online service available to customers and clients" (A: column 1, lines 65-67).

37. As per claim 16, the system of claim 11 is as described above.

Reference U does not teach wherein premium listings are customized for each medical service/good provider.

Reference A teaches wherein premium listings are customized for each medical service/good provider (A: column 14, lines 14-16). In light of the specification, the examiner interprets multiple entries to exist each with its own information.

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Reference U with Reference A. One of ordinary skill would have been motivated to combine these teachings Reference A discloses that "for a company to develop an online presence, creating a world-wide web server would provide a feature rich online service available to customers and clients" (A: column 1, lines 65-67).

38. As per claim 18, the system of claim 10 is as described above.

Reference U does not teach wherein the discount price list and the medical service/good provider listing are searchable by the members using one or more search criteria.

Reference A teaches wherein the discount price list and the medical service/good provider listing are searchable by the members using one or more search criteria (A: column 14, lines 1-3).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Reference U with Reference A. One of ordinary skill would have been motivated to combine these teachings because Reference A teaches that it will "implement online searchable directories of information" (A: column 4, lines 42-43).

39. As per claim 19, the system of claim 18 is as described above.

Reference U does not teach wherein one of more search criteria is based on geographic area.

Reference A teaches wherein one of more search criteria is based on geographic area (A: column 14, lines 10-12; column 14, lines 25-28).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Reference U with Reference A. One of ordinary skill would have been motivated to combine these teachings Reference A teaches that it will "implement online searchable directories of information" (A: column 4, lines 42-43).

40. As per claim 20, the system of claim 18 is as described above.

Reference U does not teach wherein one of the search criteria is based on the services and goods provided by the medical service/good providers.

Reference A teaches wherein one of the search criteria is based on the services and goods provided by the medical service/good providers (A: column 14, lines 10-12).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Reference U with Reference A. One of ordinary skill would have been motivated to combine these teachings because Reference A teaches that it will "implement online searchable directories of information" (A: column 4, lines 42-43).

41. As per claim 21, the system of claim 1 is as described above.

Reference U does not teach further comprising one or more advertisements provided by the network provider to the members.

Reference B teaches further comprising one or more advertisements provided by the network provider to the members (A: column 14, lines 20-31).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Reference U with Reference A. One of ordinary skill would have been motivated to combine these teachings Reference A discloses that it will "develop an online presence" (A: column 1, lines 65-67).

42. As per claim 22, the system of claim 21 is as described above.

Reference U does not teach wherein the advertiser pays the network provider an advertising fee to provide the advertisements to the members.

Reference A teaches wherein the advertiser pays the network provider an advertising fee to provide the advertisements to the members (A: column 14, lines 30-31).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Reference U with Reference A. One of ordinary skill would have been motivated to combine these teachings because Reference B discloses that it will "develop an online presence" (A: column 1, lines 65-67).

43. As per claim 23, the system of claim 21 is as described above.

Reference U does not teach wherein the advertisement provided to a member is based on one or more search criteria used to search the medical service/good provider listing.

Reference A teaches wherein the advertisement provided to a member is based on one or more search criteria used to search the medical service/good provider listing (A: column 14, lines 25-28).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Reference U with Reference A. One of ordinary skill would have been motivated to combine these teachings because Reference A discloses that it will "develop an online presence" (A: column 1, lines 65-67).

44. As per claim 24, Reference U teaches a method for providing a health care plan comprising:

- a. Receiving a membership fee from one or more individuals to become members of the health care plan (i.e. For a low monthly fee of just \$5 (single)...to receive Dental Club...services (U: page 19)) and participate via incentives within a member multi-level network (i.e. The Dental Club is a program designed for individuals, which allows members to access dental services at significantly reduced rates when they visit a participating contracted dentist (U: page 3));
- b. Providing a discount price list that regulates the cost of services/goods provided to the members by the medical service/good providers such that the members pay the medical service/good providers in-full directly for any services/goods rendered based on the discount price list (i.e. FDH also provides, if paid annually, a Dental Club identification card, a list of service providers, a schedule of fees...(U: page 19)).

Reference U does not teach obtaining information from one or more medical service/good providers that have joined the health care plan.

Reference A teaches obtaining information from one or more medical service/good providers that have joined the health care plan (A: column 12, lines 56-65). In light of the specification, the examiner interprets "online service user

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interaction" to be the same as being able to obtain information from one or more medical service/good providers.

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Reference U with Reference A. One of ordinary skill would have been motivated to combine these teachings Reference A discloses that "with the increasing popularity of computer communications, many companies are becoming interested in advertising and supporting their products using an online computer service that can be accessed by customers" (A: column 1, lines 18-21).

45. As per claim 28, Reference U teaches a method for providing a health care plan comprising:

- a. Receiving a membership fee from one or more individuals to become members of the health care plan, i.e. For a low monthly fee of just \$5 (single)...to receive Dental Club...services (U: page 19).
- b. Providing a discount price list that regulates the cost of services/goods provided to the members by the medical service/good providers such that the members pay the medical service/good providers in-full directly for any services/goods rendered based on the discount price list (i.e. FDH also provides, if paid annually, a Dental Club identification card, a list of service providers, a schedule of fees...(U: page 19)).

Reference U does not teach obtaining information from one or more medical service/good providers that have joined the health care plan.

Reference A teaches obtaining information from one or more medical service/good providers that have joined the health care plan (A: column 12, lines 56-65). In light of the specification, the examiner interprets "online service user interaction" to be the same as being able to obtain information from one or more medical service/good providers.

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Reference U with Reference A. One of ordinary skill would have been motivated to combine these teachings Reference A discloses that "with the increasing popularity of computer communications, many companies are becoming interested in advertising and supporting their products using an online computer service that can be accessed by customers" (A: column 1, lines 18-21).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheetal R. Rangrej whose telephone number is 571-270-1368. The examiner can normally be reached on 4/10.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Nolan can be reached on 571-272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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